

-II-  
Remarks

A. Interview

During the Telephone Interview on September 15, 2006, Applicant explained that DE 198 36 585 to Plzak ("Plzak") did not show:

- i) activating the catalyst as required by Applicant's claim; and
- ii) activating the catalyst for at least 12 hours.

Applicant also explained to the Examiner that a person of ordinary skill in the art reading Plzak would expect that the catalyst in the Plzak description would work immediately.

Applicant also told the Examiner that the method as claimed would produce water without the catalyst being activated and that 12 hours is required before CO will be oxidized.

The Examiner understood the differences; however, the Examiner did not believe that a limitation on how the catalyst was made was a limitation in the method of oxidizing CO.

Applicant disagreed. The Examiner requested case law on the point.

B. 35 USC 103 Rejection

Claims 1-26 have been rejected by the Examiner as being unpatentable over Plzak.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP 706.02(j) citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As described above, the Examiner has not established a prima facie case of obviousness. The prior art does not teach or suggest all of the claim limitations. There is no suggestion or motivation in the prior art to modify the reference teachings to the claimed invention. There is not an expectation for success.

The only issue left is to determine whether or not the steps recited for making the catalyst in the claim are a limitation for the process claim.

The materials on which a process is carried out must be accorded weight in determining the patentability of a process. MPEP 2116 citing *Ex parte Leonard*, 187 USPQ 122 (Bd. App. 1974).

So as a general principal, the materials recited in method or process claim must be given weight in determining the patentability of a process.

The applicant claims a process of oxidizing CO by using a catalyst, the catalyst itself must be given weight in determining the patentability of the process of oxidizing CO. The applicant has chosen to define the catalyst used in the process of oxidizing CO by defining how the catalyst is made. This is a perfectly acceptable practice.

The Federal Circuit has indicated that a process for using a composition of matter is independently patentable from the composition of matter. *Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 354 (Fed. Cir. 1986). Examining the process claim at issue in *Studiengesellschaft* shows that defining the process oxidizing CO by how the catalyst is made is an acceptable practice. This practice was not an issue in the case. However the claim read as follows:

1. Method for the production of high molecular polymers which comprises contacting an alpha-olefin with a catalyst formed by a mixture of a first and second component, said first component essentially consisting of an aluminum compound of the general formula  $RR'AlX$ , in which R and R' are each a member selected from the group consisting of hydrogen, alkyl radicals and aryl radicals, and X is a member selected from the group consisting of hydrogen, halogen atoms, alkoxy radicals, and aryloxy radicals, said second component essentially consisting of a non-ionized heavy metal compound selected from the group consisting of salts and freshly precipitated oxides and hydroxides of metals of Groups IV-B, V-B and VI-B of the Periodic System including thorium and uranium, metals of Group VIII of the Periodic System and manganese, and recovering the high molecular polymer formed.

*Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 354-55 (Fed. Cir. 1986).

If the method of how the catalyst was formed was not considered a limitation in the above claim, it would be highly unlikely that it would have been allowed. A claim for producing a high molecular polymer requiring contacting an alpha-olefin with a catalyst seems to be overly broad. The above claim was probably allowed because of the claim limitations describing how the catalyst was formed.

There are many patents that have a process limited by how the catalyst was formed. A few examples are Patent Nos. 7,091,385, 7,098,366, and 7,060,766. Many more examples can be found.

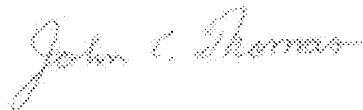
-III-  
Miscellaneous Translation Issue

If the Examiner continues to reject the Application based on Plzak, Applicant respectfully requests a translation pursuant to MPEP 706.02(II).

- IV -  
Conclusion

In view of the above, it is submitted that the claims now presented in the application are in condition for allowance. Accordingly, reconsideration and allowance of the claims are requested.

Respectfully submitted,



John C. Thomas III  
Reg. No. 52,282  
Paul A. Beck & Associates, P.C.  
Suite 100  
1575 McFarland Road  
Pittsburgh, PA 15216-1808  
Telephone (412) 343-9700  
Fax (412) 343-5787  
Customer No. 09961